

REMARKS

Formal matters:

In the specification, various paragraph have been revised to correct for minor typographical errors as well as to correct the numbering of the Tables.

A red-lined version of the specification showing changes between the continuation specification filed for this application on August 8th, 2001 and the parent specification USSN 08/185,899, filed January 26, 1994 is also enclosed.

Claims 58-78 are now pending for prosecution in this case. Claims 58-78 have been examined and are rejected on various grounds. These rejections are addressed in the appropriate sections below. As submitted herewith, Claims 58, 60-62, 65-67, 69-72 and 75-77 are amended. The Examiner has acknowledged that claims 58-78 are free of the prior art.

No new matter is added by above amendments.

The Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 58-62, 64-67, 69-72 and 74-77 stand rejected under 35 U.S.C. § 112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Specifically, the Examiner has objected to claims 58-60, 62, 64, 65, 67, 69, 70, 72, 74, 75 and 77 because they contain the word "modified".

Continuing, the Examiner has also objected to claims 61, 66, 71 and 76 for reciting the word "residues".

Applicants respectfully submit that the claim amendments renders moot the rejection under 35 U.S.C. § 112, Second Paragraph.

The Rejection under 35 U.S.C. § 112, First Paragraph

Claims 58-78 stand rejected under 35 U.S.C. § 112, First Paragraph, as allegedly containing subject matter that is not described in the specification in a manner so as to show possession of the invention.

Specifically, the Examiner makes the following observations:

(1) Generic claim 58 and dependent claims 61, 66, 71 and 76 recite a residue substitution at heavy chain Kabat residue 60, but Figure 3 (SEQ ID NO:8) shows that there is "Y" residue and not an "A" residue as shown in Table 9 (now 10); and

(2) Generic claim 58 and dependent claims 63, 68, 73 and 78 recite a residue substitution at heavy chain Kabat residue 61, but Figure 3 (SEQ ID NO:8) shows that there is an "A" residue and not an "asparagine" [sic. aspartic acid - D] as shown in Table 9 (now 10).

In response, Applicants kindly direct the Examiner's attention to the attached appendix which recites a comparison between the Kabat and sequential residue numbering. While the specification recites the Kabat residue nomenclature (numbering above), the claims recite a sequential nomenclature (numbering below). The Examiner in the parent application requested the sequential as opposed to Kabat sequence nomenclature in the claims.

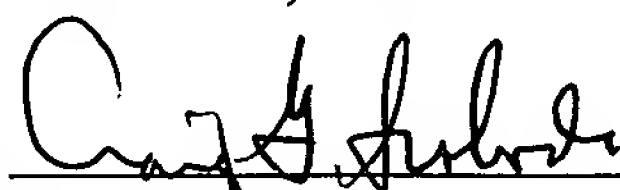
Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, First Paragraph.

Applicants believe that this application is now in condition for immediate allowance and respectfully request that the outstanding rejections be withdrawn and this case passed to issue. No new matter has been introduced, and entry of these amendments is respectfully requested. Reconsideration and further examination of the claims is respectfully requested.

The examiner is invited to contact the undersigned at (650) 225-1489 in order to expedite the resolution of any remaining issues.

Respectfully submitted,
GENENTECH, INC.

Date: December 18, 2003

By: 
Craig G. Svoboda
Reg. No. 39,044

09157

PATENT TRADEMARK OFFICE

1 DNA Way, MS 49
South San Francisco, CA 94080
Phone: (650) 225-1489
Fax: (650) 952-9881

Variable domains of SEQ ID NOs: 8 - 9 and mutants 8a, 8b and 9 using Kabat and sequential numbering

	100	110
Kabat		
SID NO: 8	CAR[GSHYFGHWHFAV]	WGQGTGLVTVSS
Mutant 8b	CAR[GSHYFGHWHFAV]	WGQGTGLVTVSS
Mutant 8a	CAR[GSHYFGHWHFAV]	WGQGTGLVTVSS
Mutant 9	CAR[GSHYFGHWHFAV]	WGQGTGLVTVSS
Sequential	100	110